

AMENDMENTS TO THE DRAWINGS:

Applicant submits herewith replacement drawing sheets 1-16.

REMARKS

This Amendment is responsive to the Office Action dated October 2, 2008. In the Office Action, the drawings were objected to and Applicant submits herewith corrected drawings to moot the objection. The Office Action also requested that Applicant update the specification to include the present status of Application No. 10/188,547, and Applicant has included a requested amendment herein to address the Office Action's concern. Applicant would also initially like to thank the Examiner for the withdrawal of the Election of Species II.

Claims 1-19 and 26-29 are pending in the application. Of these claims, claims 16 and 27 are withdrawn from consideration. In the Office Action, all of the pending claims are rejecting in view of Yoon, U.S. Patent No. 5,954,731 (hereafter "Yoon"), alone or in combination with WO Publication No. 00/54662 to Marucci et al. Applicant has carefully reviewed the arguments presented in the Office Action, and respectfully requests reconsideration of the pending claims in view of the remarks presented below.

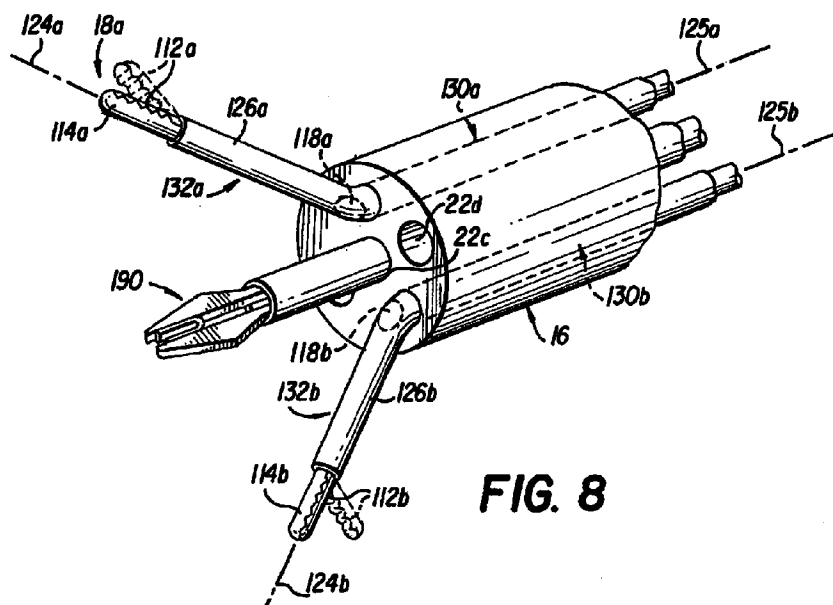
Anticipation Under 35 U.S.C. §102

Claims 1-10, 13-15, 17-19, 26, and 29 stand rejected in the Office Action as being anticipated by Yoon. Anticipation, requires identity of invention: the claimed invention, as described in appropriately construed claims, must be the same as that of the reference, in order to anticipate. Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1267, 20 USPQ2d 1746, 1748 (Fed.Cir. 1991); see also In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed.Cir. 1990) ("the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it"). The question becomes whether Yoon's disclosure placed a person of ordinary skill in possession of Applicant's invention. For the reasons set forth below, Applicant respectfully contends that it does not.

Claim 1 is reproduced below for convenience:

1. A tissue acquisition device, comprising:
an elongate main body having a proximal end, a distal end, and a length therebetween;
a first jaw member and a second jaw member each pivotally connected to the distal end of the main body,
wherein the first and the second jaw members are adapted to move from a first configuration to a second expanded configuration in which the jaw members are translationally positioned into apposition with each other, and
wherein the first and the second jaw members each define an opening for acquiring tissue therewithin, each opening being in fluid communication with at least one lumen defined in the main body.

The Office Action points to Yoon and asserts that Yoon teaches the claimed first and second jaw members as elements 18a and 18b of the Yoon disclosure, specifically citing Figure 8 thereof (reproduced below):



If Yoon is to anticipate Claim 1, then the mechanisms 18a, 18b must satisfy all the limitations of the first and second jaw members of Claim 1. Claim 1 recites that the first and second jaw members "each define an opening for acquiring tissue therewithin." The Office Action fails to identify the required opening, but it will for purposes of argument presume that the Office Action intended the gap between what Yoon calls *jaws* 112, 114 to be the opening for acquiring tissue. If this gap is the required opening (and Applicant is unaware of any other part of elements 118a,b that acquire tissue "therewithin"), then the Office Action was required to show that this gap between the two Yoon *jaws* was in "fluid communication" with at least one lumen defined in the main body. Since no fluid is communicated between the gap in the Yoon *jaws* and the end of the shaft **16** of Yoon, there can be no anticipation. The Office Action asserts incorrectly that the "jaw members define an opening in fluid communication with lumens 130a, 130b" (Office Action, p. 4), but there is no support for this assertion and, even if true, fails to establish that a fluid communication exists between the lumen and the "opening" in the jaws that acquires tissue. There is simply no evidence of record to establish a fluid communication (e.g., a vacuum condition) between the lumen 130 and the opening of jaws 118a, 118b, and therefore a *prima facie* case of anticipation has not been established.

Because Claim 1 is not anticipated by Yoon, and because the only rejection of Claim 1 is the purported anticipation of Claim 1 by Yoon, Claim 1 is asserted to be in allowable condition. Further, since all claims depend directly or indirectly from Claim 1, all pending claims are now in condition for allowance. Moreover, Claim 7 recites that the handle has "a lever for actuating the first and second jaw member in a scissoring motion." The Office Action failed to establish that Yoon's purported jaw members 18a,b can operate to move in a scissoring motion, and thus Claim 7 is independently allowable on this basis as well. Since Claim 7 was not addressed in the previous Office Action, if Claim 7 is deemed unpatentable in a subsequent Office Action, Applicant would respectfully request that the Office Action be a non-final action so Applicant may have a fair opportunity to address the merits of the rejection. In Claim 8, the jaw members are

recited to be "connected to the main body via first and second hinging members." The Office Action has previously contended that the main body is shaft 16 (Office Action, p. 3). The Office Action then relies on Figure 8 of Yoon (reproduced above) to show that the jaws 18a,b are connected to shaft 16 by hinge members 118. (Office Action, p. 4). Applicant respectfully traverses that Yoon teaches the claimed hinges, where Yoon describes the elements 118a,b as auxiliary channels and not hinges (Col. 13, lines 41 – 45). Thus, the Office Action has failed to demonstrate that Yoon teaches the claimed invention and the rejection for anticipation of Claim 8 is also properly withdrawn on this independent basis. Similarly, in Claim 9 the feature whereby the hinges are 180 degrees from each other is not shown in Figure 8, negating the rejection of Claim 9 on this additional independent ground as well.

Claim 10, which requires that the jaws' openings are 180 degrees from one another, is not shown in Figure 4 as contended by the Office Action. First, Figure 4 shows no openings since the jaws are shut. But if they were open, they would be aligned along the longitudinal axis and not 180 degrees from each other as claimed. Thus, the rejection of Claim 10 is faulty and is properly withdrawn on this basis independent of the grounds set forth above. The rejection of Claim 13 is also faulty. Claim 13 calls for "one guide rod affixed to at least the first or second jaw member." For the guide rod to be **affixed to** the jaw member, it cannot be the jaw member. The Office Action asserts that the elements 112, 114 can be construed as the guide rods. There is no support that elements 112, 114 serve any "guiding" function, but more importantly the elements 112, 114 make up the jaws that the Office Action contends invalidates the Claims. If elements 112, 114 are removed from elements 18a,b, then there is no support for the Office Action's original argument that elements 18a,b define an opening for acquiring tissue. Since elements 112, 114 must be part of what the Office Action is contending is the claimed jaw members, they cannot simultaneously be affixed to the jaw members. The rejection of Claim 13 is unsound, and is properly withdrawn on this independent basis. Claim 15, which depends from 13 and further requires that the guide rod be "curved" is

not shown nor demonstrated in the Office Action to be disclosed in Yoon and therefore is properly withdrawn on this independent basis as well.

Claim 17 further calls for a "clamping portion with clamping jaws," which the Office Action contends is shown in Figure 8 above by Yoon's "clip applier 190." There is nothing cited by the Office Action that demonstrates the structure 190 of Yoon includes clamping jaws. Therefore, there can be no anticipation of Claim 17 on this separate grounds (as well as Claims 18 and 19 that depend from Claim 17). Claim 26, which depends from Claim 18 and includes the feature of the fastening element being a "material adapted to assist in tissue ingrowth and healing." The Office Action failed to even address this feature of the claim, and therefore the rejection of Claim 26 cannot stand. Claim 27 depends from Claim 26 and was not addressed in the Office Action as well, making it independently allowable for that reason as well.

Obviousness Under 35 U.S.C. §103

Claims 11, 12, and 28 stand rejected as being obvious over Yoon in view of Mariucci et al. However, the rejections rely on the anticipation rejection of Claim 1 as their premise, which has been shown above to be faulty. Accordingly, the obviousness rejections are not supported by the record and are properly withdrawn for the reasons set forth above in connection with Claim 1.

Conclusion

Applicant has demonstrated that all pending rejections cannot be sustained, and that the pending claims are in condition for allowance. Applicant respectfully requests early notification of same. If the Examiner believes that a telephone conference will further the prosecution of this case, the Examiner is invited to contact the undersigned at the number below.

The Commissioner is authorized to charge any deficiencies or fees in connection with this amendment to Deposit Account No. 06-2425.

Respectfully submitted,
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